are rejected under 35 U.S.C. § 103(a) as being unpatentable over Netzer in view of Silva et al.

(U.S. Patent 6,163,805).

Claims 6, 7, 10, 12, 20, 21, 24 and 26 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

Applicants note that the present invention recites a request message as well as a result

message in both independent claims 1 and 16. The Examiner has indicated that the features of

the request message as recited in claim 6, and the features of the result message as recited in

claim 7, are allowable.

However, Applicants submit that along with the cited art not disclosing the features of the

result and request messages, the cited art does not even disclose or suggest the request or result

messages at all. In other words, Netzer does not disclose any messages transmitted to and

received by an automation device, which executes an application program.

The Examiner refers to Netzer at col. 12, lines 20-35 as disclosing these messages (at

page 2 and 3 of the Office Action). Netzer describes a runtime instrumented version of a

program which is created by inserting special instructions into the original program. The

runtime instrumented version is executed to create trace files of memory accesses and system

calls Netzer, e.g., col. 3, lines 34-38). Accordingly, there is a new version of the original

program created.

According to the basis for rejection, the request message is "interpreted" to be the means

used to set up the trace file of Netzer and this set-up would inherently include the memory

address and related code to allow for a repeatable trace file of memory accesses (starting at the last sentence of page 2 of the Office Action).

Applicants first submit that Netzer is *silent* with respect to any "messages" in the section cited by the Examiner. In addition, the independent claims (1 and 16) recite that the request message includes the data addresses selected for monitoring and the corresponding code address. Netzer discloses that the value of each memory location is evaluated to determine the unique data to be stored. The memory location evaluation takes place at each window boundary (see col. 12, line 26). Thus, this leads away from the Examiner's "interpretation" that a message including a memory address is used to setup a memory access trace file since the memory location (at the window boundary) is known.

In addition, the basis of rejection uses an "inherency" argument when stating that the request message is "interpreted" to be the "means used to setup the trace file . . ." "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In this case, this technical reasoning has not been provided, particularly in view of Netzer being silent with respect to the claimed messages, and in addition, not discussing the "means" for setting up the trace file in the cited section.

Finally, Applicants respectfully submit that based on the "interpretation" of the cited art, the Examiner is inherently acknowledging use of impermissible hindsight in the rejection (relying on Applicants' own teaching). Accordingly, Applicants submit that the claims are allowable at least for the above reasons.
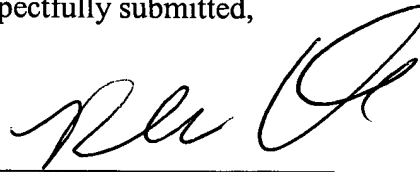
In view of the above, reconsideration and allowance of this application are now believed

to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

Ronald Kimble
Registration No. 44,186

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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23373
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